



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,257	03/09/2005	Jun Wu	34569-714.831	5292

21971 7590 11/30/2007
WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO, CA 94304-1050

EXAMINER

BRISTOL, LYNN ANNE

ART UNIT PAPER NUMBER

1643

MAIL DATE DELIVERY MODE

11/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,257

Applicant(s)

WU ET AL.

Examiner

Lynn Bristol

Art Unit

1643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☒ Claim(s) 4-8, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-8, 14 and 15 are all the pending claims for this application.
2. Claims 2, 4 and 8 were amended and Claims 9-13 were cancelled in the Response of 6/1/07.
3. The telephone interview with Applicants' representative, Shirely Chen, on 11/26/07 to discuss element b) of Claim 3 as being anticipated by prior art is made of record. Accordingly, the conditional allowance of Claims 3-7, 14 and 15 made in the Office Action of 5/8/07 is withdrawn and new grounds for rejection are raised as discussed below.
4. Claims 1-8, 14 and 15 are all the pending claims under examination.

Drawings

5. The replacement drawings for Figure 2A and 2B were received on 6/1/07. These drawings are acceptable and have been entered.

Applicants' explanation of the amended drawings on p. 3 of the Response of 6/1/07 is acknowledged.

Withdrawal of Objections

Specification

6. The objection to the disclosure is withdrawn for the following reasons:
 - a) Amended figure legend for Figure 2A and 2B now discloses protein and nucleic acid sequences;

b) Amended figure legend for Figure 3A and 3B now describes hydrophobicity analysis for the membrane region for the proteins.

c) Amended figure legend for Figure 7 now describes the expression spectrum for RL5 mRNA in tumor samples.

Applicants' amendments to the specification on p. 2 and their comments on p. 6 of the Response of 6/1/07 are acknowledged.

Claim Objections

7. The objection to Claim 2 for reciting the typographical error "is consisting of" is withdrawn.

Applicants' amendment of the claim to recite "consists of" overcomes the objection. Applicants' comments on p. 6 of the Response of 6/1/07 are acknowledged.

Claim Rejections - 35 USC § 112

8. The rejection of Claim 8 in lacking antecedent basis for the limitation "the expression conditions" in element a) is withdrawn.

The amendment of Claim 8 to recite that the protein is expressed from the expression vector of the transfected host cell overcomes the rejection. Applicants' comments on p. 7 of the Response of 6/1/07 are acknowledged.

9. The rejection of Claim 8 in lacking antecedent basis for the limitation "the culture" in element b) is withdrawn.

Element a) of the claim has been amended to recite that host cells are cultured in order to express the protein. Applicants' comments on p. 7 of the Response of 6/1/07 are acknowledged.

New Grounds for Rejection

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by McBride et al. (Clin. Chem 35(11):2196-2201 (1989)).

Claim 3 element b) is drawn in to an isolated polynucleotide that is complementary to the nucleotide encoding the polypeptide comprising amino acid sequence of SEQ ID NO:2, or the amino acid sequence of 29-213 of SEQ ID NO:2.

McBride discloses universal primers that hybridize to any genomic fragment or cDNA sequence and can be used for amplification purposes. Because the universal primers of McBride are specific but universal in their ability to recognize a complementary sequence, the primers of McBride would inherently or implicitly be fully complementary to the nucleic acid sequences of SEQ ID NO:2 in Claim 3. Further, because the claim is interpreted as reciting closed Markush group language, McBride

need only read on the one element, element b), in order to anticipate the claim.

Conclusion

11. Claims 1 and 2 are in condition for allowance and Claims 4-8, 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. A sequence search of SEQ ID NO:2 and amino acid residues 29-213 of SEQ ID NO:2; and SEQ ID NO:1 and nucleotide residues 1-639 and 85-639 of SEQ ID NO:1 was performed in commercial protein and nucleotide sequence databases, respectively. Three post-filing date references were identified which disclose the sequences of SEQ ID NO: 1 and 2 as shown in the sequence alignments provided in the Office Action of 5/8/07:

Strausberg et al. (PNAS 99:16899-16903 (December 2002)), was found to disclose a 213 amino acid residue protein having 99.5% identity with SEQ ID NO:2, and a fragment having 100% sequence identity with amino acid residues 29-213 of SEQ ID NO:2. Nucleotide residues 1-639 and 85-639 of SEQ ID NO:1 also aligned with corresponding sequences in Strasberg.

Bacon et al. (J. Immunol. 173:1078-1084 (2004)) was found to disclose a nucleotide sequence having 100% identity with residues 1-639 and 85-639 of SEQ ID NO:1, and the nucleotide sequence encoding amino acid residues corresponding to SEQ ID NO:2 and residues 29-213 of SEQ ID NO:2.


Harkin et al. (US2006134663; filed 11/3/04) was found to disclose a nucleotide sequence having 100% identity with residues 1-639 and 85-639 of SEQ ID NO:1, and the nucleotide sequence encoding amino acid residues corresponding to SEQ ID NO:2 and residues 29-213 of SEQ ID NO:2.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynn Bristol whose telephone number is 571-272-6883. The examiner can normally be reached on 8:00-4:00, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LAB



LARRY R. HELMS, PH.D.
SUPERVISORY PATENT EXAMINER